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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,645	11/25/2003	Charlton E. Lui	73270.2/40062.61USC1	8793

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EXAMINER

EISEN, ALEXANDER

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,645

Applicant(s)

LUI, CHARLTON E.

Examiner

Alexander Eisen

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/16/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, 5-10 and 12-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,683,600 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because independent claims 1, 10 and 17 of the pending application are in effect broadened versions of the independent claims 1, 5 and 9 of the Patent, and hence would be easily derived from the Patent claims by deleting some subject matter. The comparison of the independent claims is shown in the following table, whereby the similar subject matter in claims is emphasized in bold:

**Pending Application****Patent**

*1. A method of providing an adaptive pen mode selection within a pen input based computing system having one or more user selected operating modes including an ink pen input mode, a text input mode, and a data item selection mode, the method comprising: detecting a pen stroke having a location within a window on a display of the computing system, the pen stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; determining a location of all existing data items displayed within the window containing the location of the pen press, the existing data items possess properties including a data type, a position, a size, and a selection location, and a persistence age; if the computer is operating in the data item selection mode, selecting all data items having location that corresponds to the location of the pen stroke; if the computer is not operating in the data item selection mode, perform the following: determining whether the user desired to select all data items having location that corresponds to the location of the pen stroke using one or more of the properties associated with the pen stroke and the existing data items; and selecting all data items determined to be intended to be selected by the pen stroke.*

*1. A method of providing an adaptive pen mode selection within a pen input based computing system having one or more user selected operating modes including an ink pen input mode, a text input mode, and a data item selection mode, the method comprising: detecting a pen stroke having a location within a window on a display of the computing system, the pen stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; determining a location of all existing data items displayed within the window containing the location of the pen press, the existing data items possess properties including a data type, a position, a size, and a selection location, and a persistence age; if the computer is operating in the data item selection mode, selecting all data items having location that corresponds to the location of the pen stroke; if the computer is not operating in the data item selection mode, perform the following: determining whether the user desired to select all data items having location that corresponds to the location of the pen stroke using the direction property of the pen stroke and the persistence age of the existing data items; and selecting all data items determined to be intended to be selected by the pen stroke; wherein*

*the selection location for the data item comprises a selection location, a selection size, and a selection direction; a pen stroke is within the selection location when the pen stroke location corresponds to a location within the area defined by the selection location, the selection size, and the selection direction; and the selecting all data items determined to be intended to be selected by the pen stroke further comprises: determining if*

**10. A computer program product readable by a computing system and encoding a set of computer instructions for providing an adaptive pen mode selection within a pen input based computing system having one or more user selected operating mode including an ink pen input mode, a text input mode, and a data item selection mode, comprising: detecting a pen stroke having a location within a window on a display of the computing system, the pen stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; determining a location of all existing data items displayed within the window containing the location of the pen press, the existing data items possess properties including a data type, a position, a size, and a selection location, and a persistence age; if the computer is operating in the data item selection mode, selecting all data items having location that corresponds to the location of the pen stroke; if the computer is not operating in the data item selection mode, perform the following: determining whether the user desired to select all data items having location that corresponds to the location of the pen stroke using the direction property of the pen stroke and the persistence age of the existing data items; and selecting all data items determined to be intended to be selected by the pen stroke; wherein the pen**

**direction of the pen stroke is in a selection direction; determining if the location of the pen stroke is within the selection location of all data items; determining if the persistent age of all data items is greater than a predetermined period; and if direction of the pen stroke is in a selection direction, selecting all data items having the pen stroke within the selection location and the persistent age is greater than the predetermined period.**

**5. A computer program product readable by a computing system and encoding a set of computer instructions for providing an adaptive pen mode selection within a pen input based computing system having one or more user selected operating mode including an ink pen input mode, a text input mode, and a data item selection mode, comprising: detecting a pen stroke having a location within a window on a display of the computing system, the pen stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; determining a location of all existing data items displayed within the window containing the location of the pen press, the existing data items possess properties including a data type, a position, a size, and a selection location, and a persistence age; if the computer is operating in the data item selection mode, selecting all data items having location that corresponds to the location of the pen stroke; if the computer is not operating in the data item selection mode, perform the following: determining whether the user desired to select all data items having location that corresponds to the location of the pen stroke using the direction property of the pen stroke and the persistence age of the existing data items; and selecting all data items determined to be intended to be selected by the pen stroke; wherein the pen**

*stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; the properties of the pen stroke are used in determining whether the user intends to select all data items having location that corresponds to the location of the pen stroke; the existing data items possess properties including a data type, a position, a size, and a selection location, and a persistence age; and the properties of the existing data items are used in determining whether the user intends to select all data items having location that corresponds to the location of the pen stroke.*

**17. A pen input based computing system having adaptive pen mode selection within one or more user selected operating mode including an ink pen input mode, a text input mode, and a data item selection mode, the computing system comprising: a programmable processor; a user display**

*stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; the properties of the pen stroke are used in determining whether the user intends to select all data items having location that corresponds to the location of the pen stroke; the existing data items possess properties including a data type, a position, a size, and a selection location, and a persistence age; the properties of the existing data items are used in determining whether the user intends to select all data items having location that corresponds to the location of the pen stroke;*

*the selection location for the data item comprises a selection location, a selection size, and a selection direction; a pen stroke is within the selection location when the pen stroke location corresponds to a location within the area defined by the selection location, the selection size, and the selection direction; and the selecting all data items determined to be intended to be selected by the pen stroke further comprises: determining if direction of the pen stroke is in a selection direction; determining if the location of the pen stroke is within the selection location of all data items; determining if the persistent age of all data items is greater than a predetermined period; and if direction of the pen stroke is in a selection direction, selecting all data items having the pen stroke within the selection location and the persistent age is greater than the predetermined period.*

**9. A pen input based computing system having adaptive pen mode selection within one or more user selected operating mode including an ink pen input mode, a text input mode, and a data item selection mode, the computing system comprising: a programmable processor; a user display**

*configured to generate pen strokes corresponding to user created pen movements across the display; one or more data items having properties including a data type, a position, a size, and a selection location, and a persistence age; an user interface module for capturing user generated pen strokes; and a data item input module for determining whether data items are to selected by a pen stroke; wherein the pen stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; and the data item input module determines whether the user intends to select all data items having location that corresponds to the location of the pen stroke using the direction property of the pen stroke and the persistence age of the existing data items and selects all data items determined to be intended to be selected by the pen stroke.*

*configured to generate pen strokes corresponding to user created pen movements across the display; one or more data items having properties including a data type, a position, a size, and a selection location, and a persistence age; an user interface module for capturing user generated pen strokes; and a data item input module for determining whether data items are to selected by a pen stroke; wherein the pen stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; and the data item input module determines whether the user intends to select all data items having location that corresponds to the location of the pen stroke using the direction property of the pen stroke and the persistence age of the existing data items and selects all data items determined to be intended to be selected by the pen stroke;*

*the properties of the pen stroke are used in determining whether the user intends to select all data items having location that corresponds to the location of the pen stroke; the properties of the existing data items are also used when the data item input module determines whether the user intends to select all data items having location that corresponds to the location of the pen stroke; the selection location for the data item comprises a selection location, a selection size, and a selection direction; a pen stroke is within the selection location when the pen stroke location corresponds to a location within the area defined by the selection location, the selection size, and the selection direction; and the data item input module selects all data items determined to be intended to be selected by performing the following: determining if direction of the pen stroke is in a selection direction; determining if the location of the pen stroke is within the selection location of all data items;*

	<i>determining if the persistent age of all data items is greater than a predetermined period; and if direction of the pen stroke is in a selection direction, selecting all data items having the pen stroke within the selection location and the persistent age is greater than the predetermined period.</i>
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Moreover, the subject matter of dependent claims 2-3, 5-9, 12-16, 18 and 19 of the pending application is similar to that of dependent claims 2-4, 6-8 and 10-12 of the Patent. As it was pointed earlier, a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

***Allowable Subject Matter***

3. Claims 1-25, pursuant for a terminal disclaimer, are conditionally allowed.
4. The following is a statement of reasons for the indication of allowable subject matter: none of the prior art has been found that suggested a combination with or a modification of the prior art pertinent to the invention and cited below so as to arrive to the combination of the limitations of the independent claims 1, 10 and 17, namely, none of the prior art teach or suggest a pen input based computing system, and associated with it method and computer program, having adaptive pen mode selection within one or more user selected operating mode including an ink pen input mode, a text input mode, and a data item selection mode, the computing system comprising: a programmable processor; a user display configured to generate pen strokes corresponding to user created pen movements across the display; one or more data items having

properties including a data type, a position, a size, and a selection location, and a persistence age; an user interface module for capturing user generated pen strokes; and a data item input module for determining whether data items are to selected by a pen stroke; wherein the pen stroke possesses properties including the location including a starting location, and ending location, a direction, and one or more segments of constant slope; and the data item input module determines whether the user intends to select all data items having location that corresponds to the location of the pen stroke using the direction property of the pen stroke and the persistence age of the existing data items and selects all data items determined to be intended to be selected by the pen stroke.

5. The following is the prior art, which is considered to be pertinent to the invention by mode of showing the state of the art and not contesting a patentability:

**Mizobuchi et al., US 2004/0119763 A1**, discloses a pen selection method in a pen-based user interface (PBUI), wherein a number of object can be selected by encircling them with a pen, but does not disclose selection modes and usage of properties of a stroke and objects as claimed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (571) 272-7687. The examiner can normally be reached on M-F (9:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alexander Eisen', with a stylized flourish at the end.

Alexander Eisen  
Primary Examiner  
Art Unit 2629

24 April 2006